REMARKS

Applicants respectfully thank the Examiner for his thoroughness and attention to detail in the preparation of the present Office Action. The Examiner has produced an Office Action that is very clear and easy to follow.

Objection to Drawings

The Examiner has objected to the drawings because they do not include a label referenced in the specification, label 500. The Examiner has also objected to the drawings because they include label 502, which is not mentioned in the specification. Applicant has amended the specification to replace references to label 500 with references to label 502.

Objection to Specification

The Examiner has objected to the specification because the spacing of lines of the specification is such as to make reading an entry of amendments difficult. A substitute specification with double-spaced lines is provided herewith.

Additionally, the Examiner has objected to the specification because of the use of the word 'blank' at lines 24 and 26 of page 17. Applicant has amended the specification to replace the term 'blank' with the term 'input-box'.

Claim Rejections Under 35 U.S.C. § 102(b)

At paragraph 9 of the present Office Action, the Examiner has rejected Claims 1, 9, and 17 as being anticipated by U.S. Patent No. 6,085,334 to Aoki (*Aoki*). Applicants respectfully submit that Claims 1, 9, and 17 are not anticipated by *Aoki*, and Applicants respectfully traverse the Examiner's rejections in view of the arguments and amendments submitted herein.

Applicants respectfully submit that *Aoki* does not anticipate the present invention because *Aoki* fails to teach or suggest elements of Applicants' invention as recited in the claims. As is

well settled in the law, anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, *each and every element* of a claimed invention, as well as disclosing *structure which is capable of performing* the recited functional limitations. *RCA Corp. v. Applied Data System, Inc.*, 730 F. 2d 1440, 221 USPQ 385 (Fed. Cir. 1984); *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F. 2d 1540, 220 USPQA 303 (Fed. Cir. 1983).

Applicants respectfully traverse the Examiner's rejection, insofar as it might be applied to the amended claims, because the cited prior art fails to teach or suggest each and every element recited by Applicants' claims as amended herein. Specifically, *Aoki* does not teach or suggest, "a browser client creating an entry representing a page in a hotlist of pages in response to a user designating a page as a page of interest" as recited in exemplary Claim 1. With respect to the above feature, page 4 of the current Office Action generally cites *Aoki*, which generally discloses a method of organizing and clustering search results on a server-based search engine. The server-based nature of *Aoki* is clearly disclosed in the specification of *Aoki* (Column 5, line 20-28), when line 20 mentions that

> the server **12** includes a user information data base **121**, a cluster data base **122**, a contents data base **123**, a control unit **124**, a leaf node selection unit **125**, a partial cluster generating unit **126**, a recursively clustering unit **127**, a document updating/retrieving unit **128** and a resource discovering engine **129**...

This is further clarified in column 5, lines 54-61 where *Aoki* discloses

> the contents database **123** is also connected with the resource discovering engine **129**. The engine **129** which is in general called as "ROBOT" automatically collects the document index information through the internet **11**, and stores the document index information into the contents data base **123**. Thus, the addition and the update of individual documents in the cluster can be automatically and unperiodically detected.

More specifically, the cited text discloses clustering and data organizational apparatus for a search engine when it mentions:

> The present invention provides a document retrieval method for retrieving and updating individual documents of a plurality of documents, the method comprising: a leaf node selection step of selecting a specific number of documents from all of the documents assigned to the leaf node; a partial cluster generation step of assigning non-selected documents respectively to a leaf node to be similar the documents in the cluster; and a recursively clustering step of recursively repeating the leaf node selection step and the cluster generation step

toward a direction of the leaf node cluster. (Col. 2, lines 49-65 as cited by the Examiner).

The technology disclosed in *Aoki* does not concern a hotlist on a browser client, as is recited in Applicants' Claim 1. Rather, it discloses a search engine technology. This search engine of *Aoki* is easily distinguished from Applicant's recitation of "a browser client creating an entry representing a page in a hotlist of pages in response to a user designating a page as a page of interest." Because of the basic differences between Applicants' hotlist and *Aoki*'s search engine logic, *Aoki* does not anticipate Applicants' claims. Further, the differences between *Aoki*'s server-based search logic and Applicants' client-based hotlist are highlighted by *Aoki*'s failure to mention any response to user input, and instead operating automatically.

Aoki also does not anticipate the present invention because *Aoki* fails to teach or suggest "the browser client, responsive to discovering at least one keyword within the page, incorporating the at least one keyword into a keyword field of the entry in the hotlist of pages." The Examiner cites Col. 2, lines 49-65, as disclosing this functionality. Those lines are quoted above. As discussed above, the cited text generally discloses a method of organizing and clustering search results on a server-based search engine. It does not teach or suggest a hotlist, which is a user-selected interface, much less of integrating keywords into entries in a hotlist. Because *Aoki* does not teach or suggest the hotlist recited in Applicants' claim or "incorporating the at least one keyword into a keyword field of the entry in the hotlist of pages", Applicants respectfully submit that Applicants have overcome the Examiner's rejections of Claims 1, 7, and 9 under 35 U.S.C. 102(b).

Additionally, *Aoki* does not render Applicants' invention obvious. In an obviousness analysis under 35 U.S.C. § 103, the question is whether the prior art, considering its scope and content and the level of ordinary skill, must suggest the combination of separate elements into the claimed invention. *Laitram Corporation v. Cambridge Wire Cloth Co.,* 226 U.S.P.Q. 289, 293 (D. Md. 1985). According to its own objectives, *Aoki* is directed to "a cluster of a massive

number of documents by a low calculative quantity" and "a plurality of suitable documents" (column 2, lines 38-46), while Applicants' disclosure offers an invention that is suitable for selecting individual documents from a hotlist. Considering the scope and content of *Aoki*, it would not be obvious to one skilled in the art to create Applicants' invention from the teachings of *Aoki* for the simple reason that search engines on servers do not generally suggest the claimed methods for creating content of hotlists in browser clients.

Claim Rejections Under 35 U.S.C. § 103(a)

At paragraph 14 of the present Office Action, the Examiner has rejected Claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,848,410 to Walls *et al.* (*Walls*) "in view of would have been obvious to one or ordinary skill in the art at the time that the invention was made" (hereafter referred to as "well-known teachings in the art"). Applicants respectfully submit that Claims 1-24 are not rendered obvious by the combination of *Walls* with well-known teachings in the art and respectfully traverse the Examiner's rejection in view of the arguments and amendments submitted herein.

A. The Cited Art Expressly Teaches Away from the Proposed Combination

At paragraph 14 of the present Office Action, the Examiner has cited Col. 2, lines 35-41 of *Wells* as disclosing that "representing a page with hotlists or bookmarks would have allowed a user to return to web pages at a future time." The Examiner cites to this instance of bookmarks in the *Walls* reference as supporting the combination of *Walls* with the indexing resource disclosed in *Walls*. When taken as a whole, the *Walls* reference teaches away from the combination of the method of indexing disclosed in *Walls* with a system of bookmarks. Specifically, in the same column cited by the Examiner, *Walls* notes, "The burden of developing such a collection of bookmarks lies with the user, requiring significant time and effort...such prior systems and methods for finding and organizing desired information often fail..." (Col 2, lines, 47-59). *Walls* is directed to a "a method for continuous web indexing" (Col. 3, lines 52-54) and providing the user with a comprehensive index (Col. 3, lines 64-67), while Applicants' invention is suitable creating keywords for a discrete list of user-selected pages, as discussed

above with respect to the Examiner's rejection under 35 U.S.C. § 102. Because *Walls* specifically deprecates the use of client-side bookmarks in Column 2, and then proposes a server side replacement in the form of a server-side index, *Walls* teaches away from the combination suggested by the Examiner.

B. The Examiner Cites no Motivation for the Proposed Combination

Additionally, Applicants respectfully traverse each of the Examiner's rejections because the Examiner has failed to cite a motivation for the combination of *Walls* with well-known teaching in the art, which motivation is a necessity for the cited combination to render Applicants' invention obvious. As set forth in MPEP 2143, the first criterion for establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to...combine reference teachings." In evaluating motivation or suggestion to combine reference teachings, "a prior art reference must be considered in its entirety, i.e., as a whole" (emphasis in original). MPEP 2141.02, citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983) *cert. denied*, 469 U.S. 851 (1984).

When taken as a whole, *Walls* discloses a system for indexing on a server. *Walls* is directed to a "a method for continuous web indexing" (Col. 3, lines 52-54) and providing the user with a comprehensive index (Col 3., lines 64-67), while Applicants' invention is suitable creating keywords for a discrete list of user-selected pages, as discussed above with respect to the Examiner's rejection under 35 U.S.C. § 102. The content disclosed by well-known teaching in the art, on the other hand, is unclear. In view of the teachings of the references as taken as a whole, it is apparent that there is no objective suggestion or motivation in the cited references (or generally in the art) that would lead a skilled artisan to combine the reference teachings to obtain the present invention. If such suggestion or motivation existed, the Examiner would have, no doubt, cited by column and line number a passage in one of the references cited or a well-known teaching in the art to discharge his duty to "explain why the combination of the teachings is proper." MPEP 2142, citing *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. Appl & Inter. 1986). Instead, the Examiner merely notes that "representing a page with hot lists or bookmarks would have allowed a user to return to a web page at a future time."

As is discussed in MPEP § 2144.03(E), facts cited as common knowledge should be of notorious character and serve only to "fill in the gaps" in an unsubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without

evidentiary support in the record as the principal evidence on which a rejection was based. M.P.E.P. § 2144.03(E), citing *In re Zurko*, 258 F.3rd 1379, 1385, U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). The combination of *Walls* with well-known teaching in the art does not render Applicants' invention obvious, because the prior art does not teach or suggest the desirability of the combination of Applicants' invention. Relying on well-known art for motivation requires more than a mere attempt to "fill the gaps" as discussed in *Zurko*.

Because the Examiner's combination of references is not supported by any objective teaching in the references or art, Applicant believes that the examiner has failed to establish a *prima facie* case of obviousness. In view of the foregoing, Applicants believe the Examiner's rejection of Claims 1-24 under 35 U.S.C. § 103 is overcome.

C. The Proposed Combination Does not Show All Features of Applicants' Invention

Additionally, Applicants respectfully submit that *Walls* cannot support the combination of separate elements into the claimed invention, because *Walls* does not teach or suggest the individual elements of Applicants Claims. Specifically, with respect to Claims 1, 9, and 17, the Examiner concedes in paragraph 16 of the present Office Action that *Walls* does not teach or suggest "a browser client creating an entry representing a page in a hotlist of pages in response to a user designating a page as a page of interest." The cited text of *Walls* also does not teach Applicants' recited feature of "the browser client searching the page for keywords." The Examiner alleges that *Walls* discloses this functionality at Col. 3, lines 64-67, where *Walls* discloses that "[p]referably, the continuous indexer searches all of the one or more files within the at least one file system, providing the user with a comprehensive index of the information within the at least one file system." Applicants respectfully submit that providing the user with a comprehensive index of information within an entire file system is distinctly different from Applicants' disclosure invention of searching for keywords in a discrete list of user-selected pages, as discussed above with respect to the Examiner's rejection under 35 U.S.C. § 102. *Walls* refers specifically to such a comprehensive information index production when it notes that

> A further advantage of the continuous indexer is that it searches all selected sources of information and provides the user with a comprehensive index of the subject matter of all the information within the designated sources. (Col. 8, lines 20-24).

Applicants' invention is not directed a *comprehensive* index. Instead, it is directed to a hotlist, which allows the user to provide shortcuts to "pages of interest" to the user.

Further, the cited text of *Walls* also does not teach Applicants' recited feature of "the browser client, responsive to discovering at least one keyword within the page, incorporating the at least one keyword into a keyword field of the entry in the hotlist of pages" The Examiner alleges that *Walls* discloses this functionality at Col. 4, lines 51-60, where *Walls* discloses

"In one embodiment, the continuous indexer includes a file-system identifier configured to identify the file system from which the index is created, and to analyze the files of the file system to determine how the index organizing and descriptive elements are to be extracted from the files. In one embodiment, the continuous indexer includes an index builder configured to extract from the files the index-organizing elements and descriptive elements, and to organize those elements and the location element in a predetermined format. Advantageously, in one implementation, such format is alphabetical."
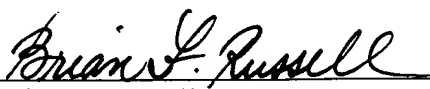
Applicants respectfully submit that nothing in the cited paragraphs teaches or shows a browser client, a hotlist, or a keyword field in a hotlist entry. Because the cited text of *Walls* does not teach or show the recited elements of the Applicants' Claims 1, 9, and 17, Applicants respectfully submit that the Examiner's rejections of those Claims, of similar Claims 6, 14, and 22, and of all dependent claims are overcome.

Moreover, Applicants' respectfully traverse the Examiner's rejection of Claims 5, 13, and 21. The Examiner asserts that *Walls* teaches "allowing the user to edit the keyword" when *Walls* discloses "the continuous indexer also includes a display manager to display specific portions of the index in response to user-generated commands" (Col. 6, lines 16-19). However, Applicants recite "allowing the user to edit the keyword field of the entry in the hotlist of pages," not merely display of the index information. Because Applicants' Claims 5, 13, and 21 recite a feature not taught or suggested by the prior art cited by the Examiner, Applicant respectfully submits that Applicant has overcome the Examiner's rejection of Claims 5, 13, and 21.

It is respectfully submitted that the claims are in condition for allowance and favorable action is requested. No extension of time is believed to be required. However, in the event that an extension of time is required, please charge that extension fee and any other required fees to **IBM Deposit Account Number 09-0447.**

Applicant respectfully requests the Examiner contact the undersigned attorney of record at (512) 472-7800 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

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